## REMARKS

This application has been reviewed in light of the Office Action dated April 22, 2004. Claims 31-34, 36, 37, 39-50, 55 and 56 are presented for examination, of which Claims 31, 55 and 56 are in independent form. Favorable reconsideration is requested.

Claims 31-33, 36, 37, 39-41, 43, 49, 50, 55 and 56 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 4,720,707 (Konishi et al.), and Claims 34, 42 and 44-48 were rejected under 35 U.S.C. § 103(a) as being obvious from *Konishi* in view of U.S. Patent 4,670,791 (Murata et al.).[1]

Claim 31 recites an information processing apparatus including obtaining means for obtaining an image by scanning a sheet, character recognition means for obtaining character data from the image by performing character recognition on the image, and determining means for determining types of the character data obtained by the character recognition means. A display controller controls a display of the image together with the character data arranged in a plurality of frames corresponding to each of the types determined by the determining means. A memory is provided for storing the image together with the character data in the corresponding frame for each type.

*Konishi* relates to a display apparatus in which plural erasable images formed on an image bearing member are transported to a display mechanism and displayed

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1/ While the rejection under Section 103(a) also refers to a "Zamora" document, since the discussion is directed entirely to *Konishi* and *Murata*, and no other mention is made of *Zamora*, it is understood that the rejection is not in fact based on *Zamora*.

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simultaneously thereon. The image bearing member moves along a determined path, along which are provided stations for image formation, display and erasure.

It is respectfully submitted that nothing in *Konishi* teaches or suggests obtaining character data from a scanned image by performing character recognition on the image, in the manner of Claim 31. The Examiner, in the absence of any explicit teaching or suggestion of character recognition in *Konishi*, relies on the following passage:

> As an example, first, second and third pages of the description of a patent specification are respectively stored in the RAMs 42, 43, 44, and first, second and third pages of attached drawings are respectively stored in the RAMs 45, 46, 47.

*Konishi* at col. 5, lines 51-55 (bold in the original). However, this passage merely states that a patent specification is stored in certain memory locations and drawings are stored in certain other memory locations. It says nothing about how these images came to be stored in these particular locations.

From the cited passage, the Examiner surmises that *Konishi*'s device inherently must have done the following: (1) performed character recognition on the images in question; (2) identified them as a patent specification and drawings; and (3) placed them in particular memory locations based on this recognition and identification. But, *Konishi* does not describe or suggest anything of the kind. Moreover, the Examiner does not provide any support for the proposition that these character recognition and

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identification steps arc <u>necessarily present</u> in *Konishi*'s device, rather than being mere

"probabilities or possibilities."[2]

In fact, the images to be stored in the RAM locations are <u>determined by the</u>

<u>user</u>, not by a character recognition and identification process, as made clear in the

following passage:

> A first area of the display unit 6 is used for displaying the
> image of a page selected from the images of three pages
> stored in the RAMs 42, 43, 44, while a second area of the
> display unit 6 is used for displaying the image of a page
> selected from the images of three pages stored in the RAMs
> 45, 46, 47. Thus the display unit 6 can simultaneously
> display two mutually related images. For example it is
> rendered possible to observe an explanation and a related
> drawing by displaying said explanation in the first area of the
> display unit 6 and said drawing in the second area thereof.
> <u>The selection of the images to be stored in the RAMs 42, 43,</u>
> <u>44, 45, 46, 47 is made by the keyboard or by keys provided</u>
> <u>in the display unit 6.</u>

*Konishi* at col. 4, line 57, through col. 5, line 2 (emphasis added).

The Examiner further cites the following passage as supposedly establishing

that *Konishi* must perform character recognition, but this supposition is disingenuous at

best:

> As explained in the foregoing, the display apparatus of the
> present invention provides for simultaneous arbitrary
> observation of selected plural images, to erasure of only the

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2/ "To establish inherency, the extrinsic evidence 'must make clear that the missing
descriptive matter is necessarily present in the thing described in the reference, and that it
would be so recognized by persons of ordinary skill. Inherency, however, may not be
established by probabilities or possibilities. The mere fact that a certain thing may result
from a given set of circumstances is not sufficient.'" M.P.E.P. § 2112(IV) (quoting *In re
Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations
omitted)).

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> images that have become no longer necessary, and alteration
> of the images within a short time. Also it is possible to erase
> a part of the displayed image, to form a new image in the
> erased area and to display said new image together with the
> unerased image to provide an edited image.

at col. 12, lines 45-53 (emphasis added). As the emphasized portions of this passage make

clear, *Konishi*'s device merely allows the erasure and superposition of images. Nowhere

does *Konishi* suggest that characters might be edited. Indeed, the image editing process is

specifically described in the immediately preceding paragraph, and it has nothing to do

with character recognition:

> It is furthermore possible to form and display an image over
> two belts 109A, 109B, then move a belt 109A or 109B to
> erase the image thereon and form and display a new image
> thereon, thus showing an edited image composed of a partial
> image newly formed on said belt and another partial image
> which has been formed on the other belt. In this manner a
> partial modification or a partial erasure can be made on a part
> of the displayed image.

at col. 12, lines 36-44. Again, *Konishi*'s editing process simply involves the erasure,

partial erasure and superposition of images.

For all these reasons, it is believed to be clear that Claim 31 is allowable

over *Konishi*.

Independent Claims 55 and 56 are method and computer memory medium

claims, respectively, corresponding to apparatus Claim 31, and are believed to be

patentable for at least the same reasons as discussed above in connection with Claim 31.

A review of the other art of record has failed to reveal anything which, in

Applicants' opinion, would remedy the deficiencies of the art discussed above, as a

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reference against the independent claims herein.  Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from independent Claim 31, and are therefore believed patentable for the same reasons.  Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100.  All correspondence should continue to be directed to our below listed address.

Respectfully submitted,
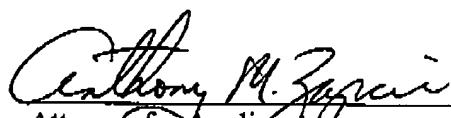
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